

**REMARKS**

**I. STATUS OF THE CLAIMS**

Claims 1-64 are pending. Claims 28-30 stand withdrawn from consideration in view of the Examiner's Election Requirement of July 5, 2007. No claim is amended in this response.

**II. REJECTION UNDER 35 U.S.C. § 103**

The Examiner rejects Claims 1-27 and 31-64 under 35 U.S.C. § 103(a) as allegedly being unpatentable over FR 2 782 917<sup>1</sup> ("the FR publication") and WO 02/067877 ("the WO publication"). The Examiner alleges that "FR teaches a Cosmetic composition for application onto skin and/or lips and/or keratin fibers contains polymeric system (I) comprising at least one dispersion of particles of film-forming polymer in aqueous phase and at least one fat substance liquid at ambient temperature and dispersed in aqueous phase." Office Action at 3. However, the Examiner concedes that "FR does not teach the claimed silicone polymers of claim 1 and the gelling agents." *Id.* at 5. In an attempt to cure the deficiencies of the FR publication, the Examiner relies on the WO publication. The Examiner alleges that the WO publication "is also directed to a transfer resistant lipstick composition," "describes high molecular weight silicones," "teaches the same volatile solvents of instant application," and "teaches gelling agents." *Id.* at 5-6. The Examiner concludes that it would have been

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<sup>1</sup> As the FR publication is not in English and as the Examiner refers to "the abstract of FR (provided on PTO-1449)" at page 7 of the Office Action, Applicants assume the Examiner is relying on the Derwent

obvious to "combine the teachings of WO and FR to arrive at the instant composition."

*Id.* at 7. Applicants respectfully disagree and traverse the rejection for at least the reason that the cited references, whether alone or in combination, do not teach or suggest every element of the present claims.

With respect to obviousness, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also M.P.E.P. § 2141 (II). It is important to note that in this evaluation the references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(vi), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Independent claim 1 of the present application recites:

A cosmetic product comprising at least two compositions wherein:

- a first composition comprises a liquid fatty phase and polymer particles dispersed in the liquid fatty phase, and
- a second composition comprises at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol.

(Emphasis added.) The FR and WO publications, on the other hand, do not teach or suggest a cosmetic product comprising at least two compositions, each comprising the elements set forth above.

As a preliminary matter, Applicants wish to clarify for the record that claim 1 of the present application does not recite silicone polymers, as asserted by the Examiner. Silicone polymers are, however, recited in currently-pending dependent claims, for example, claims 2, 6, and 7, *inter alia*. Rather, claim 1 recites, *inter alia*, "at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol." Applicants, however, will address the rejection to the extent it applies to the pending claims.

Turning to the FR publication, it does not teach or suggest all the elements of the present claims. Specifically, the FR publication does not teach a "second composition" as in the present invention, let alone a second composition comprising at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol, as recited in present claim 1. The Examiner concedes as much when she recognizes the FR publication's deficiencies. However, the Examiner fails to

also recognize that the particles of film-forming polymer are dispersed in an aqueous phase in the FR publication and they are in a liquid fatty phase in the present invention. Accordingly, the FR publication also does not teach compositions reading on the present first composition.

In an attempt to cure the deficiencies of the FR publication, the Examiner relies on the WO publication. The Examiner states that:

The invention of WO comprises a method for improving the aesthetics of a pigmented transfer resistant film on the lips comprising coating the transfer resistant film with a non-reactive wetting agent composition. [...]

The composition comprises a volatile solvent (pages 9-13) in combination pigment particles (page 6, last paragraph), polymeric film-former such as silicones, natural polymers (page 7), where WO describes high molecular weight silicones (page 8) and read on component B of the composition.

Office Action at 5-6.

In her characterization of the reference, the Examiner confuses the WO publication's "transfer resistant film" and its "wetting agent composition." The last paragraph of page 6 through the second paragraph of page 15 of the WO publication is directed to a "lip composition used to prepare the transfer resistant film." WO publication at 6. Thus, the "high molecular weight silicones" disclosed therein are possible components of the "lip composition used to prepare the transfer resistant film," i.e., the first composition, and not the wetting agent composition, i.e., the second composition.

Specifically, in the Office Action, the Examiner asserts that "Example 3 shows the lip composition with the overcoat composition (which read on the instant first and second compositions respectively)." Office Action at 6 (emphasis added). That is, the Examiner asserts that the WO publication's "overcoat composition," i.e., its "wetting agent composition," reads on the present second composition. However, all the passages of the WO publication that the Examiner cites in support of the disclosure of elements of the present claims are directed to the lip composition, which the Examiner characterizes as the first composition. It remains unclear to Applicants what the Examiner means when she states that "WO describes high molecular weight silicones (page 8) and read on component B of the composition." Office Action at 6. Clarification is respectfully requested.

Moreover, the "overcoat composition" of the WO publication does not read on the second composition of the present claims, as the WO publication does not teach or suggest the inclusion of "at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol" in its wetting agent composition. While the WO publication states that "polymeric hydrocarbons preferably having number average molecular weights greater than about 650" may be used in the wetting agent composition, all of the specifically-disclosed examples of such hydrocarbons (e.g., Indopol H-100, Indopol H-50, Parapol 700, Synton PAO 100, and Puresyn 150, 100, and 300) have molecular weights far lower than the 200,000 g/mol minimum recited in present claim 1. See WO publication at 16.

The WO publication also allows for the use of "certain types of water soluble homo- or copolymers" and "perfluoropolyethers." *Id.* at 17-18. However, no molecular weight is disclosed for the "water soluble homo- or copolymers," while the suitable perfluoropolyethers are taught to be of a general formula providing a "polymer having a molecular weight ranging from 100 to 100,000," with "a molecular weight ranging from about 500 to 50,000" being taught as "particularly preferred."

Additionally, the Examiner states that "WO also teaches fluorosilicones (of instant claim 20) in example 4." Office Action at 7. However, instant claim 20 indicates that the fluorosilicones claimed therein are high molecular weight polymers. The Examiner has provided no evidence that the WO publication, which describes its fluorosilicone as "trifluoroethyl C1-4 dimethicone" discloses a high molecular weight fluorosilicone polymer, as presently claimed. WO publication at 24. Rather, the WO publication appears to disclose the use of a low molecular weight fluorosilicone compound.

Thus, even if there was a reason or guidance to combine the references as the Examiner alleges, which Applicants do not agree with, in view of the deficiencies of both references, one of skill in the art would not arrive at the present invention. Based on the reasons set forth above, the combination of references would, at best, result in the addition of high molecular weight silicones of the WO publication to the transfer-resistant composition of the FR publication. Said composition would not include (a) polymer particles dispersed in a liquid fatty phase, and (b) at least one high molecular weight polymer having a weight-average molecular mass of greater than or equal to 200,000 g/mol in a second composition.

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Accordingly, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness and the rejection should be withdrawn.

### III. CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims. If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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